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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/473,300	12/28/99	HONBO	H 503.34465V03

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EXAMINER

MAPLES, J

ART UNIT PAPER NUMBER

1745

DATE MAILED:

08/31/00

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Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

## Office Action Summary

Application No. <b>09/473,300</b> Examiner <b>JOHN S. MARPLES</b>	Applicant(s) <b>HON BO ET AL</b>	Group Art Unit <b>1745</b>
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**—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—**

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE ONE MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication .
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

### Status

- Responsive to communication(s) filed on \_\_\_\_\_.
- This action is **FINAL**.
- Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

### Disposition of Claims

- Claim(s) 1-22 is/are pending in the application.
- Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- Claim(s) \_\_\_\_\_ is/are allowed.
- Claim(s) \_\_\_\_\_ is/are rejected.
- Claim(s) \_\_\_\_\_ is/are objected to.
- Claim(s) 1-22 are subject to restriction or election requirement.

### Application Papers

- See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- The proposed drawing correction, filed on \_\_\_\_\_ is  approved  disapproved.
- The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- The specification is objected to by the Examiner.
- The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. § 119 (a)-(d)

- Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
  - All  Some\*  None of the CERTIFIED copies of the priority documents have been received.
  - received in Application No. (Series Code/Serial Number) \_\_\_\_\_.
  - received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_.

### Attachment(s)

- |  |   |
|--|---|
| <input type="checkbox"/> Information Disclosure Statement(s), PTO-1449, Paper No(s). _____ | <input type="checkbox"/> Interview Summary, PTO-413                     |
| <input type="checkbox"/> Notice of Reference(s) Cited, PTO-892                             | <input type="checkbox"/> Notice of Informal Patent Application, PTO-152 |
| <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review, PTO-948           | <input type="checkbox"/> Other _____                                    |

## Office Action Summary

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## **DETAILED ACTION**

1. A substitute specification excluding claims 1-22 is required pursuant to 37 CFR 1.125(a) because applicant has submitted so many changes in the specification set forth in the preliminary amendment filed December 28, 1999.

A substitute specification filed under 37 CFR 1.125(a) must only contain subject matter from the original specification and any previously entered amendment under 37 CFR 1.121. If the substitute specification contains additional subject matter not of record, the substitute specification must be filed under 37 CFR 1.125(b) and must be accompanied by: 1) a statement that the substitute specification contains no new matter; and 2) a marked-up copy showing the amendments to be made via the substitute specification relative to the specification at the time the substitute specification is filed.

### ***Election/Restriction***

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-4, drawn to a first method for making graphite powder, classified in class 423, subclass 448.
- II. Claims 5-6, drawn to a second method for making graphite powder, classified in class 423, subclass 448.

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- III. Claims 10-14, drawn to a first battery, classified in class 429, subclass 231.8.
- IV. Claims 15-18, drawn to a second battery, classified in class 429, subclass 324.
- V. Claim 19, drawn to a third battery, classified in class 429, subclass 324.
- VI. Claim 20, drawn to a first method for making a battery, classified in class 29, subclass 623.1.
- VII. Claims 21-22, drawn to a second method for making a battery, classified in class 29, subclass 623.5.

In addition, if either of Groups I or II are elected, then claims 7-9 will be examined along with the appropriate group because these claims depend from certain claims in these two groups.

3. The inventions are distinct, each from the other because of the following reasons: Groups I and II are different from each other because Group I requires a dual heating step, which step is not part of the Group II subject matter. Groups I/II are distinct from each of the method Groups VI/VII because the latter required the use of a lithium oxide, which compound is not utilized in either of Groups I or II. The battery groups III-V are different than any of the method groups previously cited because the batteries could be produced by any of the proposed methods set forth in the method groups, thus

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distinguishing the groups from one another. Finally, the three battery groups III-V are distinct from one another because they include materially different steps in the production thereof, resulting in different batteries being produced. For example, Group IV sets forth a dual heating step, which step is not part of any of the other groups in preparing the battery.

4. Because the inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their recognized divergent subject matter, restriction for examination purposes is deemed proper.

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John S. Maples whose telephone number is (703) 308-1795. The examiner can normally be reached on Monday-Friday from 6:30 to 4:00. The examiner can also be reached on alternate Wednesdays.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Maria Nuzzolillo, can be reached on (703) 305-3776. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-3599.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

JSM/August 29, 2000

*John S. Maples*  
JOHN S. MAPLES  
PRIMARY EXAMINER  
GROUP 1745